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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/606,398

06/27/2003

Daniel R. Dwyer

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12/14/2004

HEWLETT-PACKARD COMPANY

Intellectual Property Administration

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EXAMINER

DO, AN H

ART UNIT

PAPER NUMBER

2853

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/606,398	Applicant(s) DWYER ET AL.	
	Examiner An H. Do	Art Unit 2853	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 17-21 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 27 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 17 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 or 12 of U.S. Patent No. 6,557,992. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Claim 17 of U.S. Application No. 10/606,398 calls for the first step of printing a decoration on a top surface of a decorated sheet using the imaging device, while claim 11 or claim 12 of U.S. Patent No. 6,557,992 calls for the first step of using the imaging device to print decoration within a predetermined area on a media sheet, the predetermined area outlining a top surface of a decorative sheet. Therefore, the first step claimed in both instant application and patent is similar.

Both claim 17 of U.S. Application No. 10/606,398 and claim 11 or claim 12 of U.S. Patent No. 6,557,992 calls for the second step of placing the decorative sheet behind the transparent door on the imaging device. Therefore, the second step claimed in both instant application and patent is not distinct.

Both claim 17 of U.S. Application No. 10/606,398 and claim 11 or claim 12 of U.S. Patent No. 6,557,992 calls for the third step of orienting the top surface of the decorative sheet to be adjacent to the transparent door, whereby the decoration may be viewed through the transparent door. Therefore, the third step claimed in both instant application and patent is the same.

The claim comparisons are shown in the following Table:

<u>U.S. Application No. 10/606,398 CLAIM</u>	<u>U.S. Patent No. 6,557,992 CLAIMS</u>
<p>17. A method of decorating an imaging device having a transparent door, comprising:</p> <p style="padding-left: 40px;">printing a decoration on a top surface of a decorative sheet using the imaging device;</p> <p style="padding-left: 40px;">placing the decorative sheet behind the transparent door on the imaging device; and</p> <p style="padding-left: 40px;">orienting the top surface of the decorative sheet to be adjacent to the transparent door, whereby the decoration may be viewed through the transparent door.</p>	<p>11. A method of decorating an imaging device having a transparent door, comprising:</p> <p style="padding-left: 40px;">using the imaging device to print decoration within a predetermined area on a media sheet, the predetermined area outlining a top surface of a decorative sheet;</p> <p style="padding-left: 40px;">providing perforations on the media sheet that outline the decorative sheet;</p> <p style="padding-left: 40px;">separating the decorative sheet from the media sheet;</p> <p style="padding-left: 40px;">placing the decorative sheet behind the transparent door on the imaging device; and</p> <p style="padding-left: 40px;">orienting the top surface of the decorative sheet to be adjacent to the transparent door, whereby the decoration may be viewed through the transparent door.</p> <p>12. A method of decorating an imaging device having a transparent door, comprising:</p> <p style="padding-left: 40px;">using the imaging device to print decoration within a predetermined area on a media sheet, the predetermined area outlining a top surface of a decorative sheet;</p> <p style="padding-left: 40px;">providing a cutting guide on the media sheet that outlines the decorative sheet, cutting along the cutting guide to separate the decorative sheet from the media sheet;</p> <p style="padding-left: 40px;">placing the decorative sheet behind the transparent door on the imaging device; and</p> <p style="padding-left: 40px;">orienting the top surface of the decorative sheet to be adjacent to the transparent door, whereby the decoration may be viewed through the transparent door.</p>

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spencer et al (US 6,042,278) in view of Liang et al (US 5,701,230).

Regarding claim 17, Spencer et al disclose in Figures 1-4 an imaging device such as a printer (Figure 1, printers 10, 12, 14), comprising the step of printing decoration (Figure 3, demo images 54, column 2, lines 21-24) on a top surface of a decorative sheet (sheets of paper from printers 10, 12, 14).

Regarding claim 18, further comprising the step of selecting the decoration from a plurality of decorations (Figure 3, demo images 54).

Regarding claim 19, further comprising the step of providing the plurality of decorations on a memory device (Figure 3, memory 56).

Regarding claim 20, further comprising the step of downloading a decoration from a remote content source (column 2, lines 31-36).

Regarding claim 21, further comprising the step of designing a custom decoration (column 2, lines 39-44).

Spencer et al do not disclose the following:

Further regarding claim 17, the decorative sheet is placed behind the transparent door and oriented to be adjacent to the transparent door, whereby the decoration may be viewed through the transparent door.

Liang et al teach in Figure 5 the following:

Further regarding claim 17, the decorative sheet (picture or photograph, column 3, lines 12-13) is placed behind the transparent door (transparent lid member 26, column 2, line 60) and oriented to be adjacent to the transparent door (transparent lid member 26, column 2, line 60), whereby the decoration (picture or photograph, column 3, lines 12-13) may be viewed through the transparent door (column 3, lines 12-16).

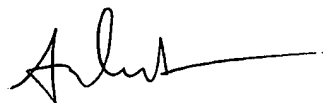
It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a transparent door with a decoration placed behind, as taught by Liang et al into Spencer et al, for the purpose of identifying, enjoyment or convenience (column 3, lines 15-16).

Contact Information

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to An H. Do whose telephone number is 571-272-2143. The examiner can normally be reached on Monday-Friday (Flexible).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on 571-272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



An H. Do
December 9, 2004